

REMARKS

The Applicant has reviewed and fully considered the April 22, 2009 Office Action received in the above-referenced application.

The drawings are objected to under 37 CFR 1.83(a) for failing to disclose all of the limitations found in Claims 3 and 13, namely the crescent-shaped jaws and the non segmented housing of the back-up tongs. The term “crescent-shaped jaws” in Claim 3 has been amended to read “semi-circular jaw” as suggested in the Office Action. The semi-circular jaw 36 can be seen in Figures 1, 2 and 4. Likewise the limitation “non segmented drive ring” has been amended to read “an angularly non-segmented drive ring”. The angularly non segmented housing of the back-up tongs 40 is highlighted in Figure 2. It is the Applicant’s position that one skilled in this particular art would understand the term semi-circular jaw particularly in view of the drawings provided in this application. Similarly an individual skilled in this art and familiar with rotating equipment would understand the term “angularly non-segmented drive ring” especially in view of the drawings and description provided. In view of these amendments the Applicant respectfully requests the objection to the drawings be withdrawn.

Claims 3 and 13 are objected to for use of the terms “crescent-shaped” and “non segmented” respectively. These claims have been amended to replace these terms as outlined above. The Applicant respectfully requests the objection to these claims be withdrawn in view of these amendments.

Claims 8 through 11 are rejected under 35 USC §103(a) as being unpatentable over Carlson (U.S. Patent Publication No. 2003/0056623) in view of Stogner (U.S. Patent No. 6,505,531). For

purposes of appeal the Applicant maintains its earlier position as to the inability to combine these two pieces of prior art.

Further for a 103 rejection to be proper, the references cited by the Examiner must disclose or suggest all the limitations of the Applicant's claim. *See In re Royka*, 490 F.2d 981 (CCPA 1974) (holding that a proper § 103 rejection requires that the prior art teach all of the claim limitations); *see also Ex parte Wada*, BPAI 2007-3733 at 7. (Jan. 14, 2008) (a post-KSR decision citing *In re Royka* and other Federal Circuit cases holding that obviousness requires a suggestion of all limitations in a claim). Because Carlson and Stogner fail to disclose all the limitations of Claims 3 and 8 alone or in combination, they are an inadequate base reference for the purpose of a 103 rejection.

The Applicant takes issue with the Examiner's position that combining the equipment disclosed in these pieces of prior art would yield the method claimed in Claims 8 through 13. The chassis the Examiner cited for the device in Carlson is a "form of a vehicle for transporting the assembly, the chassis having a ground engaging device, tracks, an engine an operators station and a main frame". (See Carlson paragraph 49 and 50 as cited in the Office Action). The element that is lacking from this disclosure is the guide columns (the vise apparatus in Carlson) being removed from the chassis. The chassis in Carlson is essentially a tractor used to operate the device. The guide columns (vise apparatus) is no more removably mounted to the chassis than the transmission of that tractor would be removably mounted to the chassis. Granted both the vise apparatus and the transmission could be removed from the chassis. However it would involve specialized labor and tools. This is not the type of undertaking done in the operation of the Carlson vise apparatus by the operator trying to drill a horizontal hole in the earth.

If the Carlson device were combined with Stogner and hung from a hoist on an oil derrick as suggest in the Office Action, a chassis such as that taught by Carlson would not be used at all. The Stogner tool is swung into place through use of the hoist and hoisting harness 120'. Stogner does not rely on any chassis to move or position the tool. So given the cited prior art there is no disclosure of the limitation of "the chassis ... removably connected to the one or more guide columns" as found in Claim 3 and the limitation of "disconnecting the one or more guide columns from the chassis" as found in Claim 8.

Claims 4 through 7 all depend either directly or indirectly from Claim 3. Likewise Claims 9, 10 and 11 all depend either directly or indirectly from Claim 8. As such the foregoing arguments would also support the allowance of these dependent claims.

Additionally Claim 7 has been amended to include the limitation of providing at least one locking mechanism to lock the back-up tong relative to one or more guide columns. Neither Carlson nor Stogner disclose providing of such a locking mechanism. Claim 14 has been added and depends from Claim 7. Claim 14 provides additional limitations directed towards the locking mechanism. Likewise Claim 15 has been added and depends from Claim 8 providing additional limitations directed towards the locking of the backup housing and guide columns. In view of the foregoing reasons, the Applicant respectfully requests the rejection of Claims 8 through 11 under 35 USC 103(a) over Carlson in view of Stogner be withdrawn.

Claims 3-7, 12 and 13 are rejected under 35 USC 103(a) as being unpatentable over Carlson in view of Stogner and in further view of Wilms (U.S. Patent No. 3,838,613). This obviousness rejection like the one discussed above is also improper for failing to recite all the limitations found in the claims. As discussed previously, Carlson and Stogner fail to disclose limitations directed

towards “the chassis ... removably connected to the one ore more guide columns” as found in Claim 3 and the limitation of “disconnecting the one or more guide columns from the chassis” as found in Claim 8. Wilms is positioned in place on the drill string through use of a supporting cable 15 and hoist mechanism (See Wilms, Col. 4, lines 44-52). Wilms does not use guide columns. Therefore it does not disclose any limitations directed towards locking the backup housing to the guide columns or providing any lockup mechanism such as those limitations found in Claims 7, 14 and 15.

In view of the reasons outlined above, the Applicant respectfully requests the rejection of Claims 3-7, 12 and 13 under 35 USC 103(a) be withdrawn.

The Applicant believes they have addressed all the outstanding issues and that the application is in condition for allowance and therefore respectfully request such.

Enclosed is a Petition and Fee for a One-Month Extension of Time. Please charge Deposit Account No. 50-1971 the amount of \$65.00 to cover this extension of time fee. Further, charge any additional fees required by this paper or credit any overpayment to Deposit Account No. 50-1971.

Should any other amendments be necessary to place the application in condition for a Notice of Allowance, Examiner Muller is invited to call the undersigned at the below noted telephone number.

Respectfully submitted,



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